Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ROBERT W. NEIL

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Appeal No. 1998-2639
Application 08/425,735

ON BRIEF

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Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice Chief Administrative Patent Judge, and WILLIAM F. SMITH, Administrative Patent Judge.

Per Curiam

Robert W. Neil (Neil or appellant) appeals from the final rejection of claims 20 through 23, all of the claims now pending in this application, under 35 U.S.C. § 102(b) as anticipated. We *reverse*.

Neil's claims on appeal are directed to a billiards cue. Claims 20 through 23 are reproduced in the appendix of Neil's original brief filed September 9, 1996. The details of those claims are not important to the decision of the appeal before us because, as we shall see, the dates of activity relied upon by the examiner fail to establish a bar to patentability of a pool cue of any description to Neil under 35 U.S.C. § 102(b).

The sole rejection before us is stated in the most recent final Office action mailed March 15, 2000,[1] the pertinent portions of which reads as follows:

> 2. ... The rejection is based on an actual pool cue in the possession of the examiner in his office. Further, as a matter of formality in line with 37 CFR 1.104(d)(2) examiner has submitted an affidavit as to the date of purchase of this cue.
>
> 3. Claims 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by a Pool Cue[sic].
>
> The reference to a Pool Cue[sic] is a physical pool cue which can be viewed by applicant in the office of the examiner of record. An affidavit of [sic, concerning] this Pool Cue[sic] is included with this action.

The undated "affidavit" (actually a declaration) which is attached to the final Office action mailed March 15, 2000, states that the examiner has in his possession a pool cue having certain physical attributes. The pool cue, the examiner says, "was purchased in the fall of 1994." The examiner's § 102(b) rejection is apparently predicated on showing the pool cue in his possession to be identical to the one claimed by Neil.[2]

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[1] Final Office actions were earlier entered on February 26, 1996, and April 24, 1996.

[2] In a per curiam decision rendered January 11, 2000, we remanded jurisdiction of this application to the patent examiner to, among other things, make clear the manner in which an updated document described by the examiner's as "Photocopy 1 and 2 of a Pool Cue purchased by examiner in the fall of 1994" (answer mailed November 26, 1996, page 3) qualifies as a prior art reference under 35 U.S.C. § 102(b). It is evident that the examiner is no longer relying on the "Photocopy 1 and 2 of a Pool Cue" as a reference under § 102(b).

35 U.S.C. § 102(b) provides:

> A person shall be entitled to a patent unless...
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

The rejection advanced by the examiner must be reversed for the simple reason that the examiner has produced absolutely no evidence whatsoever relating to the patenting, description in a printed publication, public use or sale of the pool cue in his possession, more than one year prior to the date of the application for patent in the United States as required by 35 U.S.C. § 102(b).

Whenever any rejection predicated on 35 U.S.C. § 102(b) is made, careful note must be taken of the filing date of the application (in his instance April 20, 1995), and the date of the patent, publication, or activity relied upon as the basis for the rejection (in this instance, the date of purchase of the pool cue). To bottom a rejection of Neil's claims on § 102(b), the examiner must come forward with evidence having a date on or before April 19, 1994, that is, on a date more than one year prior to the April 20, 1995, filing date of Neil's application.

The examiner says the cue was purchased "in the fall of 1994." According to Merriam-Webster's Collegiate Dictionary, Tenth Edition, copyright 1966, "fall" as used in connection with a period of the year is defined as "of, relating to, or suitable for autumn."

The American Heritage Dictionary, Second College Edition, copyright 1982, simply defines fall (among other things) as "Autumn." Autumn, of course, is the season between summer and winter, "lasting from the autumnal equinox to the winter solstice, and from September to December in the Norther Hemisphere." Id.

Unless the examiner purchased the pool cue in the Southern Hemisphere (and there is no indication that this unlikely event is the case), the time period of purchase was sometime between September and December 1994. Even were we to assume that the examiner purchased the pool cue on the earliest date that can be considered "fall" under the usual definition, that is September 1, 1994, that date is at most six months and 19 days before the April 20, 1995, filing date of the application. The "more than one year" provision of § 102(b) is simply not satisfied.[3]

Taking each of the provisions of 35 U.S.C. § 102(b) in turn, it is evident that the examiner's position is wanting.

1. The examiner has advanced no evidence that shows that the pool cue in his possession was "patented ... in this or a foreign country...more than one year prior to the date of the application for patent in the United States."

2. The pool cue itself is a thing and does not constitute a printed publication, much less "a printed publication in this or a foreign country...more than one

[3] Even were we to agree with the examiner's assertion that July 1994 is in the fall of 1994 (answer mailed May 30, 2000), which we do not, July 1994 is not more than one year prior to April 20, 1995.

year prior to the date of the application for patent in the United States."[4]

[4] The photocopies (or photocopies of photographs) illustrating the cue appear to have been made by the examiner and do not appear to be publications in the sense that the word "publication" is used in § 102(b).

3. The purchase of the pool cue itself “in the fall of 1994" doe snot evidence that the pool cue was “in public use or a sale in this country, more than one year prior to the date of the application for patent in the United States.” Assuming, without deciding, that the examiner’s declaration establishes public use or sale or the pool cue in his possession, any such public use or sale is significantly less than one year prior to the appellant’s date of application for patent in the United States.[5]

In the brief filed May 10, 2000, and the answer mailed May 30, 2000, the appellant and the examiner have referred to declarations apparently relied upon by Neil to show certain acts by Neil prior to “the fall of 1994.” The examiner, for his part, finds these materials insufficient to “eliminate the applied prior art” (answer mailed May 30, 2000, page 3). While declarations and other evidence relating to dates of conception, etc. might have bearing on a rejection under 35 U.S.C. § 102(a),[6] there is no such rejection before us for our review. Lest the point be missed, evidence of any such acts have absolutely no bearing on a rejection under 35 U.S.C. § 102(b).

[5] The examiner might reasonably believe that the pool cue was in existence prior to the time he acquired it. To serve as a bar under 35 U.S.C. § 102(b), the pool cue had to be in existence more than one year prior to April 20, 1995, the date on which Neil filed the application before us. It is possible that information concerning manufacture of the examiner’s pool cue (or others like it) may be available from the manufacturer of the pool cue or from other reliable sources of such information. It is not, however, enough to surmise that the pool cue was in existence more than one year prior to Neil’s filing date.

[6] See also 37 CFR § 1.131.

The decision of the examiner is reversed.

**REVERSED**

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| BRUCE H. STONER, JR. Chief<br>Administrative Patent Judge | ) |
| GARY V. HARKCOM<br>Administrative Patent Judge | ) BOARD OF PATENT<br>) APPEALS AND<br>) INTERFERENCES |
| WILLIAM F. SMITH<br>Administrative Patent Judge | ) |

MARY A. WHITING
214 SLOSSON AVENUE
STATEN ISLAND, NY 10314